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10/659,654	09/10/2003	Gregory A. Piccionelli	39003.811US01	3656

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EXAMINER

COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,654	Applicant(s) PICCIONELLI ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the Restriction Election filed on 11 August 2008.
2. Claims 1-28 are currently pending and have been examined.
3. All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. Applicant’s election of claims 1-27 in the reply filed on 11 August 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
5. Claim 28 is withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.
6. This Office Action is given Paper No. 20080823. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 9 and 10 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

9. Regarding claims 9 and 10:

a. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing².

b. In this particular case, the method steps are not tied to another statutory class. For example, the first step of claim 9 recites “providing a membership in a site”, but fails to identify a class of invention that performs the “providing”. Therefore, the claimed method is not a patent eligible process under § 101.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances; *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)

Claim Rejections - 35 USC § 112, 2nd Paragraph

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 6 and 7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

12. Regarding claim 6:

c. This claim recites “in step b) a tangible good is provided to the user periodically”. This claim is indefinite because one of ordinary skill in the art would not understand how “step b)” would allow for the periodic delivery of a tangible good to the user.

13. Regarding claim 7:

d. This claim recites “in step b) the membership in the destination site is renewed periodically”. This claim is indefinite because one of ordinary skill in the art would not understand how “step b)” relates to periodic membership renewal.

14. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

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Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-5, 8, 10-15, and 18-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Feathers et al. (U.S. 2002/0055933) (“Feathers”), in view of Perri, III et al. (U.S. 2001/0020231) (“Perri”), and in further view of Guerreri (U.S. 2002/0055911) (“Guerreri”).

17. Regarding claims 1, 2, 10, 11, and 19:

e. Feathers discloses the following limitations:

- i. *accessing an affiliate site on a network, the affiliate site including a hyperlink to a destination site (see ¶0015); and*
- ii. *accessing the destination site by activating the hyperlink (see ¶0015).*

f. Feathers does not specifically disclose the following limitations:

- iii. *acquiring a membership in the destination site.*

g. Perri, however, does disclose the following limitations:

- iv. *acquiring a membership in a destination site (see at least figure 2 and associated text).*

h. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the destination site of Feathers the

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membership acquisition process as taught by Perri since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

i. Additionally, Feathers/Perri does not specifically disclose the following limitations:

v. *acquiring a digital storage device including a hyperlink to a third-party site on a network;*

vi. *accessing the third-party site by activating the hyperlink included in the digital storage device; and*

vii. *conducting a transaction at the third-party site.*

j. Guerreri, however, does disclose the limitations:

viii. *acquiring a digital storage device (theme list CDs 404) including a hyperlink to a third-party site on a network (see ¶0033);*

ix. *accessing the third-party site by activating the hyperlink included in the digital storage device (see ¶0033); and*

x. *conducting a transaction at the third-party site (see ¶0033).*

k. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the method of Feathers/Perri the transaction process as taught by Guerreri since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same

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function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

18. Regarding claims 3, 12, and 20:

l. Feathers/Perri/Guerreri discloses the limitations of claims 2, 11, and 19, as shown above. Feathers/Perri/Guerreri, further, discloses the limitations:

xi. *wherein the digital storage device is a CD-ROM* (see Guerreri, ¶0033).

19. Regarding claims 4 and 13:

m. Feathers/Perri/Guerreri discloses the limitations of claims 3 and 12, as shown above. Feathers/Perri/Guerreri, further, discloses the limitations:

xii. *wherein the CD-ROM includes at least one digital data file* (see Guerreri, ¶0033).

20. Regarding claims 5 and 14:

n. Feathers/Perri/Guerreri discloses the limitations of claims 4 and 13, as shown above. Feathers/Perri/Guerreri, further, discloses the limitations:

xiii. *wherein the digital data file is selected from the group consisting of an audio file, a video file, a photographic file, a graphic file and a text file* (see Guerreri, ¶0033; and Feathers, ¶0024).

21. Regarding claim 15:

o. Feathers/Perri/Guerreri discloses the limitations of claims 4 and 13, as shown above. Feathers/Perri/Guerreri, further, discloses the limitations:

xiv. *wherein the CD-ROM includes a hyperlink to a third-party site or a network* (see Guerreri, ¶0033).

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22. Regarding claims 18, 21, and 22:

p. Feathers/Perri/Guerreri discloses the limitations of claims 10 and 19, as shown above. Feathers/Perri/Guerreri, further, discloses the limitations:

xv. *providing a valuable consideration to the affiliate site after step b)* (see Feathers, ¶0015).

q. Feathers/Perri/Guerreri does not specifically disclose the limitations:

xvi. *providing a valuable consideration to the destination site after step e).*

r. Feathers/Perri/Guerreri, however, as shown directly above, discloses providing a valuable consideration to the affiliate site after step b).

s. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to apply the teachings of Feathers/Perri/Guerreri to also provide a valuable consideration to the destination because the destination site is providing a “referral” to the third party site just as the affiliate site is providing a “referral” to the destination site. One would have been motivated to do so because this would provide the destination site an incentive to refer customers to the third party site.

23. Regarding claims 8, 23, and 24:

t. Feathers/Perri/Guerreri discloses the limitations of claims 1 and 19, as shown above. Feathers/Perri/Guerreri, further, discloses the limitations:

xvii. *wherein a user acquiring the membership in the destination site is associated with a password that identifies the user and the affiliate site (see Feathers, ¶0015); and*

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xviii. *wherein the password further identifies the third-party site (see Feathers, figure 4 and associated text; and ¶0015).*

24. Regarding claims 25-27:

u. Feathers/Perri/Guerreri discloses the limitations of claim 19, as shown above.

Feathers/Perri/Guerreri, further, discloses the limitations:

xix. *wherein a user acquiring the membership in the destination site and the digital storage device forwards the hyperlink to the third-party site to a second user (see Perri, ¶0076);*

xx. *wherein the second user conducts a transaction at the third-party site (see Perri, ¶0076); and*

xxi. *providing a valuable consideration to the user after the second user conducts the transaction (see Perri, ¶0076).*

25. Claims 6, 7, 16, and 17, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Feathers/Perri/Guerreri, and in further view of Official Notice.

26. Regarding claims 6 and 16:

v. Feathers/Perri/Guerreri discloses the limitations of claims 1 and 10, as shown above. Feathers/Perri/Guerreri does not specifically disclose the following limitations:

xxii. *wherein in step b) a tangible good is provided to the user periodically.*

w. However, the Examiner takes Official Notice that providing tangible goods to a user periodically is old and well-known in the art because providing goods periodically

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through a membership account or subscription account allows a user to receive goods after having to go through a payment and registration process only once.

x. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include providing tangible goods periodically with the membership benefits taught by Feathers/Perri/Guerreri. One would have been motivated to do so because periodic goods provide a more efficient user shopping experience.

27. Regarding claims 7 and 17:

y. Feathers/Perri/Guerreri discloses the limitations of claims 1 and 10, as shown above. Feathers/Perri/Guerreri does not specifically disclose the following limitations:

xxiii. *wherein in step b) the membership in the destination site is renewed periodically.*

z. However, the Examiner takes Official Notice that renewing a destination site membership periodically is old and well-known in the art because renewing memberships periodically through a membership account or subscription account allows a user to reevaluate the value of their membership.

aa. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a periodic membership renewal into the membership structure taught by Feathers/Perri/Guerreri. One would have been motivated to do so because periodic membership renewal provides users with a flexible and convenient method of managing their membership accounts.

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28. Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Guerreri, in view of Official Notice.

29. Regarding claim 9:

bb. Guerreri discloses the limitations:

xxiv. *providing a membership in a site on a network to a user requesting membership* (see ¶0024).

xxv. *shipping a tangible good associated with the membership in the site to the user* (see ¶0033).

cc. Guerreri does not specifically disclose the following limitations:

xxvi. *creating a record of the shipment of the tangible good to the user.*

dd. However, the Examiner takes Official Notice that creating records of shipments of goods to user is old and well-known in the art because merchants typically use this information for relational communication between the user and the merchant post shipment.

ee. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the method of Guerreri the old and well-known record keeping process since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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30. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

31. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art

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must—at the very least—be aware of and understand the knowledge and information contained within these references.

32. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C Coppola/
Examiner, Art Unit 3621
August 23, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621